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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,334	08/03/2001	Alexander Lifson	11670.00006	4968
22910	7590	12/11/2006	EXAMINER	
BANNER & WITCOFF, LTD. 28 STATE STREET 28th FLOOR BOSTON, MA 02109-9601			NORMAN, MARC E	
			ART UNIT	PAPER NUMBER
			3744	

DATE MAILED: 12/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

NT

**Office Action Summary**

Application No.

09/921,334

Applicant(s)

LIFSON, ALEXANDER

Examiner

Marc E. Norman

Art Unit

3744

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 11-13, 15, 16, 19, 21-23, 25, 27, 28 and 39-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 is/are allowed.
- 6) ☒ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) 11-13, 15, 16, 19, 21-23, 25, 27, 28 and 39-53 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All. b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/28/05</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Supplemental Reissue Declaration***

Supplemental Declaration: A supplemental oath/declaration under 37CFR 1.175(b)(1) is required where (A) the application is otherwise in condition for allowance; (B) amendments or other corrections of errors in the patent have been made subsequent to the last oath/declaration filed in the application; and (C) at least one of the amendments or other corrections corrects an error under 35 U.S.C. 251. In this reissue application applicant has made corrections to the claims in the 10/28/2005 amendment which was submitted subsequent to the last oath/declaration (8/3/01). Accordingly, applicant needs to provide a supplemental oath/declaration prior to allowance stating *“Every error in the patent which was corrected in the present reissue application, and which is not covered by the prior oath(s) and/or declaration(s) submitted in this application, arose without any deceptive intention on the part of applicant.”*

See MPEP 1444 for guidance in handling supplemental oaths/declarations.

### ***Claim Objections***

Claim 13 is objected to under 37 C.F.R. 1.173. The claim must be fully underlined.

Claims 11 and 12 are also objected to since they depend from claim 13.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-13, 15, 16, 19, 21-23, 25, 27, 28, and 39-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 13m 16, 23, 28, 39, 43, and 48 all recite language regarding a limited flow passing through the suction line when the valve is fully closed. There appears no disclosure as to how this is obtained. A valve which is fully closed does not allow fluid to flow through. While perhaps when a valve is turned off, it may remain partially open to allow fluid flow, that is not what is claimed. Accordingly, these claims, and all claims depending therefrom, are deemed to be indefinite.

#### ***Allowable Subject Matter***

Claims 1-3 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

As per independent claim 1, the prior art does not teach the system combination recited, and in particular the limitation on means for rapidly pulsing the solenoid valve in the bypass line whereby the rate of flow of bypass to the suction line is modulated.

As per independent claim 3, prior art does not teach the system combination recited, and in particular the limitation on means for rapidly pulsing the solenoid valve in the economizer circuit whereby the rate of the economizer flow to the compressor is modulated.

#### ***Conclusion***

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Since the rejection set forth under 35 U.S.C. 112, 2<sup>nd</sup> was not previously presented, this Office Action is made non-final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc E. Norman whose telephone number is 571-272-4812. The examiner can normally be reached on Mon.-Fri., 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cheryl Tyler can be reached on 571-272-4834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MN



**MARC NORMAN**  
**PRIMARY EXAMINER**